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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *28 November 2009*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-13,19,21-24 and 34* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-13,19,21-24 and 34* is/are rejected.

7) ☒ Claim(s) *2, 19-24* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of Group I, claims 1-13, new dependent

claims 19, 21-24 and new system claim 34, in the reply filed on Response of 11/28/09 is

acknowledged and appreciated. The pending claims comprise 2 set of groups:

   1) Method: 1-13, 19, 21-24,

   2) system: 34.

   canceled claims: 14-18, 20 and 25-33.

   As of 10/16/09, independent method claim 1 is as followed:

   1. (Previously Presented) A method for protecting domain name registrations

with a permanent registration certificate, comprising:

   a) receiving a request on a permanent domain name system server with one or

more processors from a client network device via a computer network for a permanent

registration of an existing domain name registration, wherein the existing domain

name registration includes a domain name and associated information collected during

a domain name registration process on a public domain name registrar;

   b) receiving a one-time permanent registration fee payment for the existing

domain name registration on the permanent domain name system server from the

client network device;

c) creating a permanent registration for the existing domain name registration on the permanent domain name system server, wherein creating the permanent registration includes automatically determining and verifying all current renewal fee payments due for the existing domain name registration at the public domain name registrar and using a first portion of the one-time permanent registration fee payment to pay all current renewal fee payments and automatically determining and verifying all future renewal fee payments due for the existing domain name registration at the public domain name registrar and using a second portion of the one-time permanent registration fee payment to pay all future renewal fee payments;

d) issuing a permanent registration certificate for the existing domain name registration from the permanent domain name system server using the created permanent registration; and

e) providing access to the issued permanent registration certificate from the permanent domain name system server to the client network device via the computer network.

Note: for convenience, letters (a)-(e) are added to the beginning of each step.

Principles of Laws

1) Note also, it appears that this is a data processing system. In step (a), the phrase after "information/request" for "a permanent registration of an existing domain name registration ….", they are considered as non-functional descriptive material (NFDM) on the "information", thus having no patentable weight. The mere insertion of

"domain name" data over "data" <u>does not</u> "impart <u>functionality</u> when <u>employed as a</u>

<u>computer component</u>", thus having no patentable weight.

See MPEP 2106.01 "Descriptive material can be characterized as either

"functional descriptive material" or "nonfunctional descriptive material." In this context,

"functional descriptive material" consists of data structures and computer programs

which <u>impart functionality when employed as a computer component</u>. (The definition of

"data structure" is "a physical or logical relationship among data elements, designed to

support specific data manipulation functions." The New IEEE Standard Dictionary of

Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive

material" includes but is not limited to music, literary works, and a compilation or mere

arrangement of data.

Also, the source of the "data" or "information" does not further adds limitation to

the data/information and maybe considered as non-functional descriptive material.

As for the limitation "…..", they are considered as non-functional descriptive

material (NFDM) on the data of "…", thus having no patentable weight. The mere

insertion of "price" data over "data" <u>does not</u> "impart <u>functionality</u> when <u>employed as a</u>

<u>computer component</u>", thus having no patentable weight.

See MPEP 2106.01 "Descriptive material can be characterized as either

"functional descriptive material" or "nonfunctional descriptive material." In this context,

"functional descriptive material" consists of data structures and computer programs

which <u>impart functionality when employed as a computer component</u>. (The definition of

"data structure" is "a physical or logical relationship among data elements, designed to

support specific data manipulation functions." The New IEEE Standard Dictionary of

Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive

material" includes but is not limited to music, literary works, and a compilation or mere

arrangement of data.

2106.01 Computer-Related Nonstatutory Subject Matter [R-6]

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and >In re< *Warmerdam*, 33 F.3d *>1354,< 1360-61, 31 USPQ2d *>1754,< 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See >Diamond v.< *Diehr*, 450 U.S. *>175,< 185-86, 209 USPQ *>1,< 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims.

In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See ** *Lowry*, 32 F.3d **>at< 1583-84, 32 USPQ2d **>at< 1035 **; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

I. FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES" REPRESENTING DESCRIPTIVE MATERIAL *PER SE* OR COMPUTER PROGRAMS REPRESENTING COMPUTER LISTINGS *PER SE*

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer

element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. **When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim**. ** When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.

Note that the computer program is claimed in a in a process where the computer

is executing the computer program's instructions, USPTO personnel should treat the

claim as a process claim.

Claim Objections

2.   Claims 19, 21-24 are objected to under 37 CFR 1.75(c), as being of improper

dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 deals

with "an **existing** domain name registration which includes **a domain name** and

associated information collected during a domain name registration process...". It's not

clear how dep. claim 19 with another or different domain name, "accepting **a** domain

name ..." further limits "the **existing** domain name registration which includes **a domain

name** and .." of claim 1.

3.   Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Claim 2 has a different

statutory category type, an article in the form of "a computer-readable medium having

stored therein instructions for .... to execute the steps of the **method of claim 1**". Claim

2 does not further limit the method steps of claim 1. There is nothing in claim 2 which

will further limits the steps "receiving ...", "receiving...", "creating...", "issuing ....", and

"providing..." of claim 1. It's recommended that claim 2 be written in independent claim

form (CRM form) and to include the method steps of claim 1 as shown below:

        A computer-readable storage medium having stored thereon a computer

program for *"xxxx"*, the computer program comprising a routine set of instructions which

when executed by a computer machine cause the computer machine to perform the

steps of: *"xxxx"*.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Claim <u>34</u> is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

1) Claim elements (5) of "means for receiving a request on a permanent domain

name system", "means for receiving a one-time permanent registration fee payment",

"means for creating a permanent registration ..." , "means for issuing a permanent

registration certificate", "means for providing access..", is a means plus function

limitation that invokes 35 U.S.C. 112, sixth paragraph. However, <u>the written description</u>

<u>fails to **disclose** the corresponding structure, material, or acts for the claimed function</u>.

Pages 11-36 have been reviewed but the written description fails to disclose the

corresponding structure, material, or acts for the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or

step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly

recites what structure, material, or acts perform the claimed function without introducing

any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification

already implicitly or inherently discloses the corresponding structure, material, or acts so

that one of ordinary skill in the art would recognize what structure, material, or acts

perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

2) Claim elements (5) of "means for receiving a request on a permanent domain name system", "means for receiving a one-time permanent registration fee payment", "means for creating a permanent registration ..." , "means for issuing a permanent registration certificate", "means for providing access..", is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly **link or associate** the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. Pages 11-36 have been reviewed but the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

6.   Claims 1-13, 19-24 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In independent claims 1 and 34, it's not clear what happens to the "received request" of the first step? Any response to the "received request"?

2) Claims 12, 13 recites the limitation "the step of accepting a one-time permanent registration fee payment" in lines 1-2. There is insufficient antecedent basis for this limitation in claim 1.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

9.   **Claims 1-3, 9, 12-13, 19, 23-24 (method), and 34 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN et al in view of Domain Name Registration.com, KORITZINSKY et al and MARITZEN et al.**

As for independent claims 1 (method) and 34 (system), **BURSTEIN et al** fairly discloses a method and system for managing/maintaining a domain name system comprising the functions (step of and means for) of:

a) receiving a request on a domain name system server with one or more processors from a client network device via a computer network for a maintenance of registration of an existing domain name registration, wherein the existing domain name registration includes a domain name and associated information collected during a domain name registration process on a public domain name registrar;

{see Figs. 1, 2, 5, 6, col. 1, lines 27-40, 63-67, col. 2, line 5-65, col. 4, lines 40-67, col. 5, lines 5-40, col. 6, lines 15-50, col. 7, lines 5-67}

b) receiving a one-time registration fee payment for the existing domain name registration on the permanent domain name system server from the client network device;

{see col. 2, lines 40-60 "...*registrant has registered a domain name, paid the associated fees and met certain conditions, ..*"

c) creating a registration for the existing domain name registration on
the domain name system server,

d) issuing a registration receipt for the existing domain name registration from the
domain name system server using the created registration; and

{see Fig. 1, inherently included in the system of BURSTEIN et al for customer's
verification or confirmation of a official/valid registration for doing business. See general
teaching of "confirmation of a request" on col. 14, lines 45-47 "... *sending a confirmation*
message..."}

e) providing access to the issued registration information and confirming data
from the domain name system server to the client network device via the computer
network.

{see Figs. 1, 5, 10-11, col. 6, lines 15-50, col. 7, lines 5-65, col. 8, lines 1-45}

As for the limitation of a "registration certificate" in step (d) instead of a "receipt",
this is a well known practice and inherently included in the teaching of BURSTEIN et al
so company can be sure to carry out the business using legal and verified domain
name.

Note on col. 2, lines 40-50, BURSTEIN et al discloses that domain name service
(web hosting and e-mail) is for use for a specific period of time (well known 1 year
subscription period or yearly subscription service of $35/yr) and the domain name

represents the "*business*" so "it can be *viewed* as *a significant asset* for certain registrants".

BURSTEIN et al fairly teaches the claimed invention except for the type of fee payment in step (b), i.e. "a one-time permanent registration fee" payment and subsequent feature of "permanent registration certificate" on step (c) and wherein creating the permanent registration includes automatically determining and verifying all current renewal fee payments due for the existing domain name registration at the public domain name registrar and using a first portion of the one-time permanent registration fee payment to pay all current renewal fee payments and automatically determining and verifying all future renewal fee payments due for the existing domain name registration at the public domain name registrar and using a second portion of the one-time permanent registration fee payment to pay all future renewal fee payments;

In a similar domain name management system, **Domain Name Registration .com** is cited to teach the features of:

1) require a one time fee payment arrangement for initial registration, $75.00, which covers 2 charges, one is a registration fee of $6.00 (conventional/well known fee) set by ICANN or InterNIC, and the 2nd charge is $69.00 (or the difference) for paying the service provided by Domain Nam Registration.com for registering the domain name for the client/user.

2) providing a certificate (a copy of the confirmation) for providing registration of a domain name for a permanent period (two years) with a one-time payment fee and no monthly charges and with payment options for paying online using secure server. The

copy indicates that the domain name registration step is approved and registered and

that "*your new domain name will be set up to access a Temporary page on the Web like

this*". {see pages 1-2}.

Therefore, it would have been obvious to modify the teachings of BURSTEIN ET

AL by providing a "**certificate**" as taught by Domain Name Registration.com for the

purpose of indicating that the domain name registration step is approved and registered

and ready for use. Also, it would have been obvious to modify the teachings of

BURSTEIN ET AL by determining a "**fee arrangement amount**" to cover the necessary

charges such as paying registration fees and other service fees provided by the service

provider which is what happens in the "one stop shopping" concept of BURSTEIN et al,

as shown in col. 4, lines 40-67.

In another subscription service, **KORITZINSKY et al** teaches steps for receiving

request for verifying /checking status, including subscription status of a service,

determining and verifying expiration dates, updating the status making payment to

restore the subscription service registration according to the agreement by the user, and

granting access to the user for checking status and other conditions {see Figs. 1, 8, 7,

9, 12, 15, col. 20, lines 59-67, col. 21, line 1 to col. 23, line 15}. KORITZINSKY et al

also discloses several types of fee payment options (financial management

arrangements) that may be provided to the subscriber for different levels of service,

such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or

non-expiring warranty service {see col. 21, lines 15-50}. In view of the general

problems with respect to the **expired subscribed service** for the domain name

registration and the significant impact of the domain name for many businesses "_a significant asset_", it would have been obvious to a person having ordinary skill in the art (herein after as "PHOSITA") at the time of the invention was made to modify the yearly/annual fee payment teachings of BURSTEIN et al/Domain Name Registration.com with a <u>permanent</u> fee payment as taught by KORITZINSKY et al to obtain the benefit of **lifetime** or **<u>non-expiring warranty</u> service**, thus protecting the "_a significant asset_" for life/permanently if desired.

Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service.

As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

In another system/method for computer-based fee processing for electronic commerce, **MARITZEN et al** teaches the steps of:

<u>automatically</u> tracking, determining, calculating and verifying all current fee payments due for the existing e-commerce transaction after retrieving fee rules from a fee rule database and a determining step detects the fee rules applies to information in a transaction event object, and wherein the fee rules would likely be <u>contractual fee rules</u> based on <u>conditions in agreements or contracts or license agreement or subscription service</u> in order to overcome inefficient and troublesome problems of manually processing as cited in col. 1, lines 24-59. See Figs. 2B, 2C, Fig. 4, element 52 "*Other Fee Rules*", Fig. 5, cols. 1-2, col. 3, lines 10-20, col. 6, lines 1-10. MARITZEN et al also teaches the step of "**totalizing all payments** for an entity for **a given time period** and wherein the period can be daily, weekly, or monthly, etc., After the payment is made, marks the fee objects that have been paid. See col. 8, lines 51-67 and col. 9, lines 1-5.

Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as "PHOSITA") at the time of the invention was made to modify the system/method of BURSTEIN et al/ Domain Name Registration.com / KORITZINSKY et al to include the steps of <u>automatically</u> tracking, determining, calculating and verifying all current fee payments due for the existing e-commerce transaction after retrieving fee rules from a fee rule database as taught by MARITZEN et al to overcome the inefficient and troublesome problems cited above. As for the limitation of using a first portion using a first portion of the one-time permanent registration fee payment to pay all

current renewal fee payments and automatically determining and verifying all future

renewal fee payments due for the existing domain name registration at the public

domain name registrar and using a second portion of the one-time permanent

registration fee payment to pay all future renewal fee payments, this is inherently

included in the teaching of Domain Name Registration.com above and in view of the

teachings of BURSTEIN et al /Domain Name Registration.com /KORITZINSKY et al, it

would have been obvious to modify the general teachings of <u>automatically</u> tracking,

determining, calculating and verifying all current fee payments due into 2 portions to

take care of two separate issues of current renewal payments to take care of current

period and future renewal payments to take care of all future periods.

Note the feature of "permanent" on the system such as request, payment, server,

registration, certificate, etc., are inherently included when carrying out the functions of

BURSTEIN et al in view of Domain Name Registration.com, KORITZINSKY et al and

MARITZEN et al. Furthermore, this "permanent" feature could be considered as non-

functional descriptive material (NFDM) for the reason cited above and may not have any

patentable weight. The mere insertion of "<u>permanent</u>" data over "data" <u>does not</u> "impart

<u>functionality</u> when <u>employed as a computer component</u>", thus having no patentable

weight. The last three steps merely call for "creating and issuing a electronic document

contain some information about domain name registration and services" and then

<u>providing access to the electronic document</u> to a client via the computer network.

As for dep. claim 2 (part of <u>1</u> above), which deal with well known computer

readable medium having stored therein instructions for causing a processor to execute

the steps of method claim 1, this is inherently included in the online system of

BURSTEIN et al /KORITZINSKY et al or MARITZEN et al claim 13.

As for dep. claim 3 (part of 1 above), which deals with well known digital data

processing management system, i.e. creating an electronic item (certificate) and store

the item in the databases, this is fairly taught in BURSTEIN et al Figs. 1-2, cols. 5-6

which indicates 3 functions, registering, maintaining, modifying and updating of the

domain name system on the Internet network. This is also taught in MARITZEN et al

Figs. 1, 4, abstract. Note that the term "can be viewed" is optional language and has no

patentable weight.

As for dep. claims 9, 12-13 (part of 1 above), which deals with well known

payment parameters, i.e. electronically or manually, these are inherently included in the

registration over the Internet as taught in BURSTEIN et al or Domain Name

Registration.com or Applicant's Admitted Prior Art pages 2-6. Alternatively, the manual

payment of fee by mail or other would have been obvious because this is well known

practice.

As for claim 19 (part of 1 above), which appear to be the result of claim 1 above

and then hosting a permanent website, this is taught in BURSTEIN et al Figs. 1, 5, 6-8.

Furthermore, the various adjustment of the use of the domain name system is within the

skilled artisan and would have been obvious.

As for claims 23-24, which appear to be dealt with updating and maintaining a list

of domain name registration for the same maintenance purpose as indicated in

independent method claim 1 above, in view of the general teachings of maintaining and

updating the domain name of many business entities as taught by BURSTEIN ET AL on

cols. 5-8, and 10-12 and KORITZINSKY et al Figs. 14-15 and cols. 21-23, it would have

been obvious to apply these teachings for effectively monitoring and maintenance

(management) of these domain names.

10.   Dependent claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable

over BURSTEIN et al /Domain Name Registration.com / KORITZINSKY et al

/MARITZEN et al as applied to claims 1-3, 9, 12-13 above, and further in view of

CUMMINGS et al.

    In a similar business environment for providing financial protection of equity

asset, CUMMINGS et al discloses the use of an "equity protection insurance policy

(EPIC)" to protect the equity asset/investment in a business entity based on the

happening a fortuitous (accidental) event and protects the wealth of the equity owner

(investor) in the entity or insure the equity owners the safety of their investment/asset

{see abstract, col. 2, lines 1-19, col. 3, line 65 to col. 4, line 50, Figs. 2 and 4}. It would

have been obvious to modify the teachings of BURSTEIN et al /Domain Name

Registration.com and/or KORITZINSKY et al to include an EPIC to protect the domain

name which is a the "*a significant asset*" as mentioned by BURSTEIN et al above and

issue the policy along with the registration receipt/certificate to protect the equity

asset/investment in a business entity based on the happening a fortuitous (accidental)

event such as failing to renew subscription service as taught in BURSTEIN et al or

KORITZINSKY et al and protects the wealth of the equity owner (investor) in the entity or insure the equity owners the safety of their investment/asset.

11.   Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com /KORITZINSKY et al /MARITZEN et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al .

As for dep. claims 4-5 (part of 1 above), the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al is cited above. MANN et al, as shown on col. 2, lines 4-18, is cited to disclose well known facts that many domain names have been registered by sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names to point to their content sources.

CUMMINGS et al is cited to teach well known business practice of obtaining insurance policy and title for an equity /asset to cover financial losses associated with the equity, thus protecting the equity/asset investment in case of losses {see col. 1, lines 15-20, claim 1}. It would have been obvious to modify the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al by obtaining insurance policy and title as taught by CUMMINGS et al for the domain name registration to protect the domain names since MANN et al discloses that domain names are valuable assets/equity that can be sold for large sums of money.

12.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over

BURSTEIN ET AL /Domain Name Registration.com / KORITZINSKY et al /MARITZEN

et al as applied to claims 1-3, 9, 12-13, above, and further in view of MAPLES ET AL.

        As for dep. claim 6 (part of 1 above), the teachings of BURSTEIN ET AL /Domain

Name Registration.com /KORITZINSKY et al /MARITZEN et al is cited above. MAPLES

ET AL is cited to disclose well known business operation facts that a business entity or

company raises money for company operations and not go into debt to do so by issuing

shares for sale and reward the shareowners who profit when the shares increase in

price {see col. 1, lines 20-65}. It would have been obvious to modify the teachings of

BURSTEIN ET AL/Domain Name Registration.com / KORITZINSKY et al /MARITZEN

et al by issuing shares with the certificate to raise money for company operations and

not go into debt to do so by issuing shares for sale and reward the shareowners who

profit when the shares increase in price as taught by MAPLES ET AL above.

13.   Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

BURSTEIN ET AL /Domain Name Registration.com / KORITZINSKY et al /MARITZEN

et al as applied to claims 1-3, 9, 12-13, above, and further in view of ELLIOTT.

        As for dep. claims 7-8 (part of 1 above), the teachings of BURSTEIN ET AL

/Domain Name Registration.com and/or KORITZINSKY et al is cited above. ELLIOTT

is cited to disclose well known method for allocating investment based on the

capitalization of company/business asset (i.e. intellectual property (IP)) by issuing

leases, licensing, etc., for increasing capital which may be employed to perpetuate

further useful enterprises {see Figs. A, C, col. 1, lines 15-25 and col. 2, lines 19-62, col.

3, lines 1-55}. It would have been obvious to modify the teachings of BURSTEIN ET

AL/Domain Name Registration.com / KORITZINSKY et al /MARITZEN et al by issuing

leases or sub-leases and co-ownership certificates as taught by ELLIOTT for increasing

capital which may be employed to perpetuate further useful enterprises.

Note also that the phrase "allow ownership interest to be reserved ...." basically

reads "allows a task to be carried out". In other word, "allowing an action" is different

from actually "performing the action". "allowing" or "permitting" only requires serving

as the reason for an action though, not necessarily performing the action. This can be

done by issuing commands or orders, or entering into contracts. So even though the

entity may do something later with the equipment that is in the technological arts, the

positively recited steps of merely "causing" can be done without operating the

equipment and is not in the technological arts. Variations on this theme have been

seen in other cases, using terms like "allowing" or "permitting" an action, e.g. "allowing

a user to search a database". Again, these steps are distinct from actually doing the

action, e.g. searching.

14.   Claims 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over BURSTEIN ET AL /Domain Name Registration.com / KORITZINSKY

/MARITZEN et al et al as applied to claims 1-3, 9, 12-13, and 19 above, and further in

view of Perpetual Bond Article (Dictionary of Finance and Investment Terms, 1998,

"PERPETUAL BOND" definition", page 445}.

As for dep. claims 10-11 and 21-22 (part of <u>1</u> above), the teachings of

BURSTEIN ET AL /Domain Name Registration.com / KORITZINSKY et al /MARITZEN

et al is cited above.

Perpetual Bond Article is cited to teach a financial instrument whose profits or

interest is generated perpetually or has no maturity data, is not redeemable and pays a

steady stream of interest <u>indefinitely</u>, also called *annuity bond*. {see page 445}. It

would have been obvious to modify the teachings of BURSTEIN ET AL/Domain Name

Registration.com and /or KORITZINSKY et al by linking the payment to a financial

instrument whose profits or interest is generated perpetually or has no maturity data, is

not redeemable and pays a steady stream of interest <u>indefinitely</u>, also called *annuity*

bond as taught by Perpetual Bond Article to provide a steady stream of interest

payment that is generated perpetually or <u>indefinitely </u>for the payment of the fee if

desired. The term annuity bond reads over claim 10.

<u>Note</u>: In claim 10, step (a), the phrase "…to pay …registration" is <u>not a positively</u>

<u>recited method step</u> but, rather, is mere <u>intended use</u> of the <u>profits or interest</u> and thus

having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which

indicate that a method claim requires active, positive steps.

Response to Arguments

15.   Applicant's arguments filed 6/2/09 have been fully considered but they are not

persuasive.

        1) As for the objection of claim 2, applicant's comment that claim 2 appears to be

independent product claim (computer readable and storage medium) (CRSM) is not

persuasive because the current claim format says it still depends on claim 1 which is

improper because an <u>independent claim</u> can not depend on another <u>independent claim</u>.

It's recommended that claim 2 be written in independent claim form (CRM form) and to

include the method steps of claim 1 as shown below:

A computer-readable storage medium having stored thereon a computer

program for "*xxxx*", the computer program comprising a routine set of instructions which

when executed by a computer machine cause the computer machine to perform the

steps of: "*xxxx*".

2) As for the 112, 2nd paragraphs rejections, they have been withdrawn due to

applicant's amendments of the claims.

3) As for the 103 rejections over claims 30-31 and 32, applicant's arguments are

noted but not found to be persuasive since the claims have been canceled.

4) As for the 103 rejections with respect to claims 1-13, 19, 21-24, applicant's

arguments are noted but not found to be persuasive for the following reasons:

In response to applicant's argument that AAPA and KORITZINSKY et al is

nonanalogous art, it has been held that a prior art reference must either be in the field of

applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

with which the applicant was concerned, in order to be relied upon as a basis for

rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443

(Fed. Cir. 1992). In this case, In view of the general problems with respect to the

expired subscribed service for the domain name registration as mentioned in the AAPA

, it would have been obvious to modify the yearly/annual fee payment teachings of

AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the

<u>benefit</u> of <u>lifetime</u> or <u>non-expiring warranty</u> service. Note that the type of subscription

service in KORITZINSKY et al deals with subscribing to diagnostic system/service,

however, the type of service or subscription service is not critical since fee payment

arrangement can be applied in any subscription service. Moreover, the critical issue is

"fee payment option" and facing with the problem of expiring of service due to non-

payment, a skilled artisan would look to the teachings of fee payment options or

different levels of service and if the service is so critical while the fee payment is so

cheap, one would pick the permanent or lifetime or non-expiring warranty service to

insure lifetime service.

As for the difference in the type of subscription services, again, this is not critical

and within the skill of the artisan since the major issue is the types of fee payment

options for different levels of service and subscription to diagnostic service is one of

many teachings cited by KORITZINSKY et al.

As for the limitation of "wherein the one-time permanent registration fee is used

to pay all future renewal fees for the domain name registration", this reads over the

limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is

therefore inherently included in the teachings of KORITZINSKY et al above.

16.   In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). KORITZINSKY et al is merely cited to teach the concept of updating, verifying,

maintaining and fee payment types/levels for a subscription service.

17.   In response to applicant's arguments that "Not all claims limitations were

considered by the examiner" is noted, but they are not found persuasive because

applicant's has not cited specifically what specific limitations in the claims that are not

taught by the references and not discussed by the examiner. Note also that the

independent claims were also amended so the examiner cannot pre-address the

amended issues. Applicant's arguments fail to comply with 37 CFR 1.111(b) because

they amount to a general allegation that the claims define a patentable invention without

specifically pointing out how the language of the claims patentably distinguishes them

from the references.

18.   In response to applicant's arguments that "The claimed invention was

unpredictable, includes unexpected results and was not obvious to try", they are not

found to be persuasive because these are merely applicant's <u>opinions</u> without

"subjective evidences" or information/data indicating the result as argued. There are <u>no</u>

unpredictable includes "unexpected results" submitted or shown. There are <u>no reasons</u>

of why "it was not obvious to try" or evidences indicating "not obvious to try".

19.   In response to applicant's arguments about "There is suggestion or motivation to

modify the references", and "no objective to combine the teachings of the cited prior

art", they are not found persuasive in view of the motivation statements cited in the

rejections above. Furthermore, in **KSR**, the Supreme Court particularly emphasized

that the Federal Circuit erred when it applied the well-known teaching-suggestion-

motivation (TSM) test in an overly rigid and formalistic way when it deals with

combination of **familiar elements** according to known methods is likely to be obvious

when it does no more than yield predictable results.

20.   In response to applicant's arguments about "There is No reasonable

expectations of success for combining references", in **KSR**, the Supreme Court

particularly emphasized "the need for caution in granting a patent based on the

combination of elements found in the prior art," and discussed circumstances in which a

patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed

principles based on its precedent that "[t]he combination of **familiar elements** according

to known methods is likely to be obvious when it does no more than yield predictable

results." In this case the combination of a method of maintaining a service/registration

of domain name system disclosed by BURSTEIN et al, and Domain Name

Registration.com which teaches well known domain name registration features such as

one time fee payment arrangement for service and actual registration fee and providing

a certificate of registration so company can do business, and KORITZINSKY et al which

teaches updating and verifying subscription status, fee payments options (level of

services) and parameters including permanent or lifetime or non-expiring warranty

service and charging/paying renewal fees for various types, and MARITZEN et al which

teaches the automatically determine/calculate fee payments for various levels or

according contractual agreements, would yield a predictable result. In other word, the

claimed invention is merely a combination of old elements, and in the combination each

element merely would have performed the same function as it did separately.

Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

21.   In response to applicant's arguments on pages 30-36 which basically deal with dependent claims wherein the arguments for the independent claims discussed above are incorporated by reference, the responses to the arguments for the independent claims discussed above are incorporated here also for the dependent claims since they depend on the independent claims. It's the Examiner's position that Applicant's non-responsive and lack of specific error identifications to the Examiner's lack of patentability of other claims is taken that the applicant has admitted that the rejections of these claims are valid and these claims stand or fall together with the specific claims argued by the applicant.

Conclusion

22.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

23.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

24.   For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

25.   Any response to this action should be mailed to:
        Commissioner of Patents and Trademarks
        Washington, D.C. 20231
        or faxed to **571-273-8300**.
        Hand delivered responses should be brought to the
        US Patent and Trademark Office Customer Service Window:
        Randolph Building
        401 Dulany Street
        Alexandria, VA 22314.

26.   In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

27.   Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689